

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested.

Dependent Claims 4 and 31 are amended and rewritten in independent form and include all of the elements present in the original claims from which they depended and reclaimed as new claims 40 and 51 respectively.

Independent Claims 1 and 27 are canceled.

Claims 38 and 39 are canceled.

Claim 32 is allowed as are dependent claims 36 and 37 and should also include their dependent claims 33, 34, 35 as amended

Examiner failed to summarize the status of Claims 32-37 in the final office action summary dated 10/08/2008 as required for first and final office actions. Examiner also failed to provide proper rejection identification under paragraphs 70.30.01 and 7.31.01 through 7.33.01 when making a 35 U.S.C. 112 1st paragraph rejection. Had proper protocol been used applicant could have addressed the 112 issues in a timely manner.

Claims 32-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 32 states that the pliable sheath is used for telescopically encasing an animal toenail. However, it is unclear as to what is meant by telescopically? The specification is silent as to the terminology "telescopically".

RESPONSE

All though, applicant disagrees with examiner in that the term Telescopically is unclear and the Board of appeals also did not seem to have any problem understanding the term, in order to expedite the issuance of the application the term has been deleted in this amendment.

Claims 32-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicant has claimed that the sheath defines a telescopic relationship over the animal toenail, However, as the sheath is a singular fixed apparatus, it is unclear as to how the sheath is capable of having a telescopic relationship over the animal's toe nail.

RESPONSE

See 35 U.S.C. 112, second paragraph response above.

Applicant respectfully disagrees with examiner's conclusion that simply because the claim describes the relationship between the animal nail nothing to do with the sheath being one piece. It simply means that the and sheath as being telescopic has no bearing on the ability of one skilled in the art to make and apply the cap to an animals toe nail. The term telescopic or telescopically has sheath is slidable over the animal's toe nail and is defined as:

Pertaining:

telescopic (having parts that slide one within another)

In a telescopic relationship the parts need not be identical, one part simply slides or encompasses another part.

This terminology is widely used in patents and has been accepted for years. In fact the term was used in claim 1 of applicant's patent 4,962,731 incorporated into this application in its entirety by reference. See First Paragraph of application. The requirements under 34 USC 112 were surely satisfied in the 4,962,731 patent.

Claim 34 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a singular sub layer, does not reasonably provide enablement for any sub-layer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to reproduce the invention commensurate in scope with these claims. The specification provides an enabling discloser for a singular sheath having an external coating applied thereto. However, the specification does not provide an enabling disclosure for there to be more layers than the singular sheath and the singular external coating.

RESPONSE

It is assumed that examiner is rejecting claim 14 under M.P.E.P. paragraph 7.31. 03.

Reading the specification one fully understands that an exterior coating is applied to a sheath. Since it has long been established by the courts that "a coating" singular, means "at least one" and does not limit the scope of the invention. Therefore, a plurality a coatings would be obvious. See Baldwin Graphic Systems v. Siebert (January 15, 2007), the Federal Circuit <http://www.cafc.uscourts.gov/opinions/07-1262.pdf>

Technically, "one" means "one or more" because you can't avoid infringement by adding on.

The use of the term "any" sub-layer in reference to multiple layers is supported by the amendment herein to the specification. Claims 32-36 make reference to plural "layers" therefore the specification may be amended to reference one or more layers without broadening the scope. The specification clearly teaches a coating added to a sheath,

therefore it is obvious, to even one unskilled in the art, that if one coating can be applied surely more than one coating may be applied if desired. The addition of more than one coating would not be considered, by any examiner, to be unobvious. Therefore, the Specification is sufficiently enabling for anyone skilled in the art to understand that one or more coating could be used and that the term "any" Sub-coating refers to anyone of the coatings.

Since all of examiners' rejections and objections have been overcome by amendment or arguments applicant respectfully requests that a timely Notice of Allowance be issued in this case.

By Robert N. Montgomery
Robert N. Montgomery Reg. No. 35,291
Tel.: (337) 837-4042
Fax. (337) 837-5552
e-mail Sotech@bellsouth.net